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QM41/0901

EXAMINER	
WEISS, JR., JOSEPH	
ART UNIT	PAPER NUMBER
2725	
DATE MAILED:	
09/01/98	

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

<b>Office Action Summary</b>	Application No. <b>08/827,703</b>	Applicant(s) <b>Silkoff &amp; McLean</b>
	Examiner <b>Joseph Weiss</b>	Group Art Unit <b>3735</b>

Responsive to communication(s) filed on Apr 9, 1997.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-20 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 & 5

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### *Drawings*

1. Formal drawings are requested for this application. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the Patent and Trademark Office no longer prepares new drawings.

### *Specification*

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Objections*

3. It is noted that the claims appear to be in a random order. Applicant is encouraged to group dependent claims together. A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. This will facilitate examination of the application. See MPEP 608.01(m) and 37 CFR 1.75(g).

4. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3, sets forth collecting one or more components of exhaled breath prior to measuring. Claim 1, sets forth measuring the level of one or more components of

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collected exhaled breath on its last line. Claim 3 is simply the reverse phrasing of the last line of claim 1 and fails to further limit the invention.

***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5673690. Although the conflicting claims are not identical, they are not patentably distinct from each other because the issuance of the instantly sought claims would extend the rights to exclude sought in the claims of the parent patent cited above. Applicant must file a terminal disclaimer as per 37 CFR 1.321© to overcome this rejection. Furthermore, common ownership of both patents must be maintained to retain the claimed rights to exclude of both the parent patent and the instant application.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1 and 10, on lines 8 and 18 respectively, use of the term "vellum" is vague and indefinite. This term does not exist and was not found in either Webster's Dictionary nor in Stedman's Medical Dictionary, 26th Ed. The term "Velum" does exist and is defined as any structure resembling a veil or curtain, any serous membrane or membranous envelope or covering. This is a very broad term that could apply to any number of membranes found in the human body. One specific type of velum is the velum pendulum palati, *i.e.* the soft palate. For purposes of examining the instant application, the examiner has assumed that applicant's reference to the velum is the velum pendulum palati. Correction is required.

As to claims 2- 9 & 11-17, they are rejected as vague and indefinite based upon their dependence on claims 1 & 10.

Furthermore, claim 3 is rejected for failing to further limit the independent claim that it is dependent upon. Claim 1, sets forth measuring the level of one or more components of collected exhaled breath on its last line. Claim 3, sets forth collecting one or more components of exhaled breath prior to measuring. This is simply the reverse phrasing of the last line of claim 1 and fails to further limit the invention.

***Conclusion***

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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 5653229, 5651358, 5531218, 5447165, 5474060, 5443063, 4872483, 4688568, 4090518

Foreign Patents UK Patent # 2171017A

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph F. Weiss, Jr., whose telephone number is (703) 305-0323. The Examiner can normally be reached from Monday-Friday from 8:30 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John G. Weiss, can be reached at telephone number (703) 308-2702. The official fax number for this group is (703) 305-3590 or x3591.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

JFW  
jf weiss

August 26, 1998

  
John G. Weiss  
Supervisory Patent Examiner  
Group 3700